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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,221

09/25/2006

Takashi Sueyoshi

8007-1116

1846

466

7590

09/14/2009

YOUNG & THOMPSON

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EXAMINER

OJURONGBE, OLATUNDE S

ART UNIT

PAPER NUMBER

1796

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,221	<b>Applicant(s)</b> SUEYOSHI ET AL.	
	<b>Examiner</b> OLATUNDE S. OJURONGBE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/09/2009 has been entered. Furthermore, the amendment filed on 07/07/2009 has been entered. The amendment of 07/07/2009 supersedes the submission.

2. Claims 1-6 are pending in the application.

### ***Claim Objections***

3. Claims 1, 3 and 5 are objected to because of the following informalities:  
Claim 1 recites "component (D) being a catalyst". The word "being" is redundant in the statement and should be deleted.

Claim 1 further recites "provided that said Si-H group is introduced into a polymer". The article "a" as used in the statement is a grammatical error, because it refers to "a polymer" rather than "the polymer" of the claim.

Claims 3 and 5 recite "metal oxide fine powder". This is a grammatical error. The statement should be changed to "fine metal oxide powder"

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1,3, 4 and 6** are rejected under 35 U.S.C. 102(b) as being anticipated by **Tsumura et al (US 5,623,030)**.

Regarding **claims 1, 4 and 6**, Tsumura et al teaches a curable composition providing a cured product which comprises components (B), (C), and (D) a platinum catalyst (abstract). Tsumura et al further teaches the composition of the invention comprising an organosilicon compound containing at least one SiH group and at least one vinylsilyl group per molecule, specific examples of which include the structure of col.8, lines 1-10. Tsumura et al further teaches curing the composition of the invention over a range of temperatures (col.14, lines 20-50). The structure of col.8, lines 1-10 meets the limitation of component (C) of the instant claim.

Concerning the limitation "provided that said Si-H group is introduced by allowing a chlorosilane and/or a silanol, each having an Si-H group to react with an Si-OH group and/or an Si-Cl group left after a sol gel reaction of alkoxysilane and/or chlorosilane, each having no Si-H group", the examiner notes that this is a product-by-process limitation, and that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The

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patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Regarding **claim 3**, Tsumura et al further teaches the composition of the invention comprising fine powder of silica hydrate or anhydrous silica or silica powder (col.13, lines 37-47), and exemplifies NIPSIL-LP (col.15, lines 7-10).

6. **Claims 1-2, 4 and 6** are rejected under 35 U.S.C. 102(b) as being anticipated by **Fujiki et al (US 5,536,803)**.

Regarding **claims 1-2 and 6**, Fujiki et al teaches a silicone composition comprising an organohydrogenpolysiloxane and a platinum catalyst (abstract). Fujiki et al further teaches illustrative examples of the organohydrogenopolysiloxane of the invention to include the fourth structure of col.12, lines 32-65. The fourth structure of col.12, lines 32-65 meets the limitations of component (C) of the instant claim.

Concerning the limitation "provided that said Si-H group is introduced by allowing a chlorosilane and/or a silanol, each having an Si-H group to react with an Si-OH group and/or an Si-Cl group left after a sol gel reaction of alkoxysilane and/or chlorosilane, each having no Si-H group", the examiner notes that this is a product-by-process limitation.

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Regarding **claims 3 and 5**, Fujiki et al further teaches the composition of the invention comprising finely divided silica (col.13, line 61-col.14, line 46).

Regarding **claim 4**, Fujiki et al further teaches a cured product obtained by curing the silicone composition of the invention, simply by heating the composition to induce addition reaction (col.15, lines 5-15).

7. **Claims 1, 3 and 4** are rejected under 35 U.S.C. 102(b) as being anticipated by **Ikeno et al (US 2002/0111452)**.

Regarding claims **1, 3 and 4**, Ikeno et al teaches an organopolysiloxane composition comprising (A) an organopolysiloxane with at least two alkenyl groups bonded to silicon atoms, (B) a straight chain organopolysiloxane with a hydrogen atom bonded to a silicon atom at both terminals, (D) a hydrosilylation reaction catalyst, and (E) finely powdered silica [0008-0013]. Ikeno et al further exemplifies a composition comprising a dimethylpolysiloxane with both terminals of the molecular chain blocked by a vinyl dimethylsilyl group and having a viscosity at 25°C of approximately 1Pa.s, and a dimethylpolysiloxane with a hydrogen atom bonded to a silicon atom at both terminals of the molecular chain (wherein the proportion of silicon atom bonded hydrogen atoms = 0.13 weight %). Ikeno et al further teaches curing the composition at 60°C to prepare a sheet [0041]. The component (A), exemplified as a dimethylpolysiloxane with both terminals of the molecular chain blocked by a vinyl dimethylsilyl group and having a viscosity at 25°C of approximately 1Pa.s, and component (B), exemplified as a

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dimethylpolysiloxane with a hydrogen atom bonded to a silicon atom at both terminals of the molecular chain of Ikeno et al meet the limitations of component (A) and component (B) of the instant claim respectively.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796